

## REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. By this Amendment, claim 13 is canceled without prejudice or disclaimer, claims 46-49 are added and claims 8, 26, 27, 33 and 45 are currently amended. Claims 1-12 and 14-49 are pending in the application.

The amendments to the specification correct minor informalities noted during review and/or bring the specification and drawings into mutual conformance. No new matter is added by the amendments to the specification.

The amendments to claims 8, 26, 33 and 45 place these claims in independent form, however, these amendments are not intended to alter the scope of the claims. The amendment to claim 27 addresses minor informalities noted during review, however, this amendment is not intended to alter the scope of the claims.

New claims 46-49, the amendments to the claims and specification are supported at least by text appearing at p. 5, line 1 through p. 38, line 22 of the specification as originally filed. New claims 46-49 are similar to claim 27 et seq. but differ in scope and are allowable. No new matter is added by the amendments.

The Office Action states (p. 2) that claim 13 should be canceled. Claim 13 has been canceled without prejudice. The Office Action states (p. 2) that claim 36 should be amended to address a typographical error. Applicant does not find the referenced language in claim 36. Clarification of the rejection is respectfully requested.

**Response to Rejection Under 35 U.S.C. §102(e):**

The Office Action states (p. 3) that claims 1-31, 33-42, 44 and 45 stand rejected under 35 U.S.C. §102(e) as being anticipated by Chasen et al., U.S. Patent No. 6,760,721 B1 (hereinafter "Chasen"). Applicant respectfully disagrees with the rejection and requests reconsideration.

Anticipation is a legal term of art. Applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

The §102 rejection of claims 1-31, 33-42, 44 and 45 is believed to be in error. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

No §103 rejection has been lodged regarding claims 1-31, 33-42, 44 and 45. Accordingly, if Applicant can demonstrate that Chasen does not disclose any one claimed element with respect to claims 1-31, 33-42, 44 and/or 45, the §102

rejections must be withdrawn, and a subsequent non-final action made with a different rejection in the event that the Examiner still finds any of such claims to be not allowable.

Applicant notes the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

To clarify the legal meaning of the term "anticipation", Applicant notes the language of 35 U.S.C. §103(a):

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This language sets forth Congressional intent in clear and exact terms as to what does or does not comprise anticipation, as compared to unpatentability. The reference must contain, within its four corners, exactly the subject matter of

the claim, as it appears in the claim, in order to support a valid finding of anticipation.

It is thus inappropriate to modify (item (iii), *supra*) the teachings of the reference, for example, by ignoring affirmatively-recited portions of Applicant's claims in attempting to arrive at a finding of anticipation. In part, this is because a finding of anticipation involves determining that the subject matter recited in the claim is already in the public domain, using the rules of evidence set forth in the statute and which are further interpreted in the MPEP and case law. In order to provide evidence of anticipation, the reference must, within its four corners, set forth this subject matter (item (i) *supra*) and enable such (item (iv) *supra*) exactly (item (ii), *supra*) as it appears in the claim.

Chasen is directed to (Title) a: "System and method of managing metadata data". Chasen describes "A system and method of the present invention allow users to access, manage, and edit information about content data, often referred to as metadata. Metadata is collected from various sources, added, and maintained in a metadata database. In addition, metadata is dynamically read from the metadata database and dynamically displayed in a graphical user interface in an organized manner, such as a hierarchical tree. In the graphical user interface, a user may add, delete, and/or modify the metadata. As the user changes the metadata, the metadata database is updated and the user's changes are propagated throughout the graphical user interface such that the hierarchical tree displays the changed metadata" (Abstract).

The Office Action states (p. 3) that "'Chasen teaches ... maintaining meta data associated with another plurality of pieces of content, wherein each of the

other plurality of pieces of content is a **ripped version** of a respective one of the plurality of pieces of content in the corresponding one of the plurality of pieces of content' at col. 3, line 43 to col. 4, line 8; col. 9, lines 30-51, col. 8, line 54 to col. 9., line 6, col. 13, line 46 to col. 14, line 64, col. 16, line 59 to col. 17, line 47". Applicant disagrees that Chasen provides such teaching, for at least the following reasons.

First, Chasen is silent regarding any "ripped version" or "copied version" or "tracks copied on another disc", or of metadata associated with such, as recited in each of Applicant's independent claims. In fact, Chasen is void of the term "ripped".

Second, Chasen makes no mention of conversion of an audio file from one format and medium to another format and medium or of copying a file from a CD and converting that file to a format suitable for storage on a hard drive.

Third, Applicant teaches that the term "ripped version" is a term of art in the specification, stating (p. 1, line 24 et seq.) that such refers to copying of content from one medium and format to another medium and format, and providing an example whereby "some applications also allow songs to be copied from the source CD and stored as separate files on a local hard drive of the computer, such as in an MP3 or WMA format" and thus facilitating a situation whereby "These locally stored files can then be played back at a subsequent time directly from the local hard drive without the presence of the source CD in the CDROM drive."

Chasen makes no mention whatsoever of copying content from one form of representation and translation of such content to another form, and is also void

of any mention of storage of the another form in an electronic memory. Accordingly, Chasen cannot possibly teach or disclose anything regarding any "ripped version" or "copied version" or "tracks copied on another disc", as variously recited in each of Applicant's independent claims, or of metadata for such, and cannot possibly enable such subject matter. As such, Chasen is incapable of anticipating the recitation of any of Applicant's independent claims.

In other words, selectively ignoring aspects of Applicant's claims that are not found in the reference comprises impermissible modification of (e.g., addition to) the teachings of the reference (i.e., see item (iii) supra). Further, because none of items (ii)-(iv) needed in order to provide a valid finding of anticipation are met, item (v) cannot be met. The rejection of independent claims 1, 9, 17, 19, 21, 27, 34 and 38 fails at least four necessary criteria needed in order to determine that the subject matter of the claim is anticipated.

For at least these reasons, anticipation rejection of claims 1, 9, 17, 19, 21, 27, 34 and 38 and claims dependent therefrom is defective and should be withdrawn, and claims 1-31, 33-42, 44 and 45 should be allowed.

**Response to Rejection Under 35 U.S.C. §103(a):**

The Office Action states (p. 16) that claims 32 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chasen in view of Levy et al., U.S. Patent No. 6,505,160 (hereinafter "Levy"). Applicant notes that the Office Action states that Levy corresponds to U.S. Patent No. 6,564,263 B1, which is not a patent of record, and asks that the Examiner correct the record accordingly.

Chasen is discussed hereinabove with reference to the anticipation rejections. Chasen fails to supply the elements for which Chasen is cited. As a result, the proposed combination fails to provide the subject matter of claims 32 and 43 and thus does not meet the criteria for a finding of unpatentability set forth in MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), §2141 et seq. and §2142).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The references fail to teach or disclose the elements recited in the claims. Accordingly, the references cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the references. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the references fail to provide all of the features recited in Applicant's claims, as described with particularity hereinabove, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claim. As such, the unpatentability rejections fail all of the criteria for establishing a prima facie case of obviousness as set forth in the MPEP.

Moreover, no evidence has been provided as to why it would be obvious to combine or modify the teachings of these references. Evidence of a suggestion to combine or modify may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczkak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

Levy is directed to (Title): "Connected audio and other media objects". Levy describes embodiments whereby "Media objects are transformed into active, connected objects via identifiers embedded into them or their containers. In the context of a user's playback experience, a decoding process extracts the identifier from a media object and possibly additional context information and forwards it to a server. The server, in turn, maps the identifier to an action, such

as returning metadata, re-directing the request to one or more other servers, requesting information from another server to identify the media object, etc. The linking process applies to broadcast objects as well as objects transmitted over networks in streaming and compressed file formats." (Abstract).

In contrast, claim 32 recites "A method as recited in claim 27, wherein one or more disc identifiers in the set of disc identifiers is a digital versatile disc (DVD) identifier", while claim 43 recites "A method as recited in claim 38, wherein the particular medium comprises a particular digital versatile disc (DVD)", which recitations are not taught, disclosed, suggested or motivated by the cited references, alone or in any proper combination.

The Office Action states (p. 16 item 8) that "Chasen does not specifically teach 'one or more disc identifiers in the set of disc identifiers is a digital versatile disc (DVD) identifier'" and that "Levy teaches this limitation at col. 8, lines 9-19". Applicant disagrees.

Levy does not teach or disclose anything having to do with alteration of or maintaining of metadata. Levy instead teaches inclusion of object identifiers (OIDs) on or within media objects or files (see, e.g., col. 6, line 3 et seq.) and then linking these OIDs to established banks of metadata (see, e.g., col. 2, line 38 et seq. and col. 4, line 40 et seq.). Maintaining the linkage requires that the OID be robust (see, e.g., col. 2, line 22 et seq.; col. 3, line 24 et seq. and col. 50 et seq.) .

Because the OID may be inserted into the media object or file prior to distribution of corresponding physical copies, it is important that the data not be changeable, because then the linkage, which is the main intent of the teachings of

Levy, is lost. In other words, the teachings of Levy are rendered unsuitable for their intended purpose if the indicia or OID taught by Levy is altered or alterable. It is improper to modify the teachings of a reference in a manner that renders them unsuitable for their intended purpose, as is explained below in more detail with reference to MPEP §2143.01, entitled "Suggestion or Motivation to Modify the References". In a subsection entitled "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE", this MPEP section states that: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

Additionally, there is no teaching or disclosure, or guidance, suggestion or motivation identified in the references or by the Office Action to attempt to combine or modify, or to aid one of ordinary skill in picking and choosing elements from the diverse embodiments of the references or in assembling those elements to attempt to arrive at the subject matter of any of Applicant's claims. As such, the rejection appears to employ an inappropriate 'obvious to try' standard of unpatentability.

Such is improper, as is discussed below in more detail with reference to MPEP §2145(X)(B), entitled "Obvious To Try Rationale". This MPEP section states that "The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of

numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted)".

In this instance, no guidance in selecting some but not others of the many elements from the many embodiments of the references is identified. Similarly, no direction as to which of many possible choices is likely to be successful has been identified.

As there is no basis for the Examiner's contentions within the cited references, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to construct a reason for combining and/or modifying the teachings of the cited references. The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. (See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).).

For at least these reasons, the unpatentability rejection of claims 32 and 43 is *prima facie* defective and should be withdrawn, and claims 32 and 43 should be allowed.

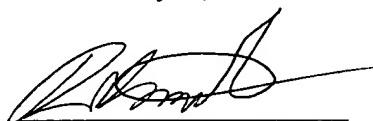
## **CONCLUSION**

All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance. Early and forthright issuance of a Notice of Allowability is respectfully requested.

Respectfully Submitted,

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